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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,857	07/31/2003	Robert Wiest	341019US28	9086
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER CARTER, CANDICE D				
ART UNIT		PAPER NUMBER		
3629				
NOTIFICATION DATE		DELIVERY MODE		
02/24/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/630,857

Applicant(s)

WIEST ET AL.

Examiner

CANDICE D. CARTER

Art Unit

3629

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 9, 18-20 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9, 18-20 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is a First Action Non-Final on the merits. Claims 1-2, 6-7, 9, 18-19, 23-24, and 27-28 have been amended. No additional claims have been cancelled. No new claims have been added. Therefore, claims 1-4, 6-7, 9, 18-20, and 22-28, as originally filed, are currently pending and have been considered below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 26, 2010 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-4, 6-7, 9, 18-20, and 22-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1, 18, and 23 recite the limitation "transacting business between an insurance and a reinsurance business". It is unclear what Applicant means by "an insurance". For examination purposes, the Examiner will interpret "an insurance" to mean "an insurance business".

Claims 1, 18, and 23 recite the limitation "the automatic process included in the standard processing unit determines whether a total sum insured of the reinsurance event exceeds a threshold to verify if a local rule applies, and verifies whether a rating engine for third party liability is not advanced enough to allow automatic rating of the reinsurance event". The Examiner asserts that this limitation is unclear because it verifies whether a rating engine is not advanced enough to allow automatic rating during the automatic process. It seems as though this determination should be performed before the automatic processing begins. For examination purposes, the Examiner will interpret this limitation as though the verification of whether a rating engine is not advanced enough to allow automatic rating is performed before the automatic process begins (i.e., not performed by the very automatic process that it is verifying).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-4, 6, 18-20, and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jinks (2002/0055862) in view of Ryan et al. (5,839,118) and further in view of Barrett (6,029,144).**

As per claims 1, 18, and 23, Jinks discloses a system for transacting business between a insurance businesses, the system comprising:

a server used by and accessible by insurance businesses (§ 7 discloses an interactive insurance server accessible by an agent interface and a carrier interface);

and a contract evaluation unit, a standard processing unit, and a non-standard processing unit, the contract evaluation unit and the standard and non-standard processing units included in the server, wherein the standard processing unit is configured to process data by an automatic process, and the non-standard processing unit is configured to process data with human intervention by an additional data input (§ 25, 28, and 40 discloses the insurance server that performs contract evaluation, standard processing, and non-standard processing);

wherein the contract evaluation unit is configured (i) to receive input data of an event from the insurance business, (ii) to determine whether the input data is complete and error free in accordance with error validation criteria (§ 24 and 25 discloses inputting data in order to obtain a premium quotation and the server determining if the agent has selected the proper class, and if not, returning the agent to the previous step to select the proper class, this process ensures that the form information is complete and error free) and (iii) to evaluate whether the complete input data has to be further processed by the standard processing unit or the non-standard processing unit (§ 6, 25, 28, and 40 discloses the server determining if the information is able to be processed by automatic means or needs to be processed manually using the system),

the complete input data is sent for further processing to the standard processing unit in a case where the contract evaluation unit determines that the complete input data

complies with underwriting rules and qualifies for at least one policy (see ¶ 6, 28, and 29),

the complete input data is sent for further processing to the non-standard processing unit in a case where the contract evaluation unit determines that the complete input data does not comply and does not qualify for at least one policy, and where the complete input data requires the human intervention (¶ 29 discloses applicants information is automatically forwarded to an underwriter if information does not comply, see also ¶ 40),

and the automatic process included in the standard processing unit verifies whether a rating engine is not advanced enough to allow automatic rating of the reinsurance event (¶ 6, 25, 28, and 40 discloses determining if the system is able to evaluate a risk and provide an insurance premium evaluation and/or if an activity is insurable by automatic means).

While Jinks discloses a system for transacting business between insurance businesses (see at least ¶ 16), Jinks does not disclose transacting business between a reinsurance business and an insurance business.

However, the Examiner asserts that the data identifying the type of business is simply a label for the business and adds little, if anything, to the claimed acts or steps and thus does not serve to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through labels (i.e., the specific type of business) which does not explicitly alter or impact the steps of the method or the

elements of the system does not patentably distinguish the claimed invention from the prior art in terms of patentability.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the businesses of Jinks to be an insurance business and a reinsurance because the specific type of business does not functionally alter or relate to the steps of the method or the elements of the system and merely labeling the information differently from that in the prior art does not patentably distinguish the claimed invention.

In addition, the Examiner also considers a third party liability rating engine to merely be a label for the rating engine as well, therefore, the same analysis can be applied to the rating engine.

Jinks, also, fails to disclose determining if input data fits a predetermined acceptable range, the predetermined acceptable range being an ideal range of acceptable premiums, and where the complete input data includes at least a premium from the insurance and determining if input data falls outside of the predetermined acceptable range; and determining whether a total sum insured of the reinsurance event exceeds a threshold to verify if a local rule applies.

Ryan discloses a system and method for premium optimization and loan monitoring, determining if input data fits a predetermined acceptable range, the predetermined acceptable range being an ideal range of acceptable premiums, and where the complete input data includes at least a premium from the insurance and determining if input data falls outside of the predetermined acceptable range (at least

claim 1 discloses determining if a premium structure includes a projected before tax cash value that falls within a predetermined acceptable range).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify systems and methods for interactively evaluating a commercial insurance risk of Jinks to include determining if a premium payment falls within a predetermined acceptable range as taught by Ryan in order to determine an optimal premium structure (see abstract).

Barrett discloses a compliance to policy detection method and system determining whether a total sum of an event exceeds a threshold to verify if a local rule applies (col. 14, line 11-20 discloses determining if expense entries exceed a threshold value greater than the sum of all fraud possibility codes which occurs when rule is repeatedly violated).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system of Jinks to include determining if an event exceeds a threshold to verify if a local rule applies as taught by Barrett since modifying the automatic process as described in Jinks to include the known technique of using a threshold to determine if a rule has been violated would have predictably resulted in determining if a specific event violates any rules of the system and/or method. See KSR [127 S Ct. at 1739].

As per claims 2, 19, and 24, Jinks discloses wherein said contract evaluation unit determines that the input data is not complete, then the insurance is alerted to complete

the input data (§ 25 discloses returning the an agent to a previous step so that they may complete the data by selecting the proper class).

As per claims 3, 22, and 25, Jinks discloses the contract evaluation unit is further configured to evaluate whether the complete input data has to be further processed by the standard processing unit or the non standard processing unit is based on one or more rules, that is associated with a business model (at least § 28 discloses that the determination of whether the complete input data can be further processed automatically or manually is based on a series of underwriting rules).

The Examiner considers the reinsurance business model to be a label for the business model, and, therefore, would have been an obvious modification to the business model of Jinks. See a similar, more detailed, analysis above with respect to claims 1, 18, and 23.

As per claims 4, 20, and 26, Jinks discloses the standard processing unit or the nonstandard processing units are configured to operate with a perquisite of a given range of variables (§ 24 discloses a given set of possible classes of insurance for which an agent is authorized to provide automated quoting information, where the variables are the classes of insurance).

As per claims 6 and 27, Jinks discloses wherein the standard unit and the non-standard processing unit are configured to accept the complete input data of the insurance and are configured to inform the insurance that a contract has been formed based on the complete input data (§ 15 and 34 discloses once policy information is

submitted automatically creating a binder for the policy and transmitting the policy binder to the agent, where the binder is the contract).

7. Claims 7, 9, and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Jinks in view of Ryan in view of Barrett and further in view of Walker (5,794,207).

As per claims 7 and 28, the Jinks, Ryan, and Barrett combination discloses all of the elements of the claimed invention but fails to explicitly disclose the standard processing unit and the non-standard processing unit are configured to inform the insurance with a counter offer.

Walker discloses a method and apparatus for facilitating buyer driven conditional purchase offers presenting a solicitor with a counteroffer (col. 22, line 40-42 discloses a seller responding to a solicitor with a counteroffer).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system of the Jinks, Ryan, and Barrett combination to include presenting an insurance with a counteroffer since the modification of the method and system with the known technique of notifying a solicitor of a counteroffer would have predictably resulted in enabling negotiations of an optimal contract that will satisfy both parties. See KSR [127 S Ct. at 1739].

As per claim 9, the Jinks, Ryan, and Barrett combination discloses all of the elements of the claimed invention but fails to explicitly disclose the standard processing unit and the non-standard processing unit are configured to inform the insurance that a contract cannot be formed.

Walker discloses signaling the solicitor that a contract cannot be formed (col. 9, line 45-50 discloses that a seller may respond to a CPO by sending a counteroffer through the central controller, where, by sending the counteroffer, the central controller is notifying the solicitor that the contract cannot be formed because the seller did not agree to the original terms of the contract).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system of the Jinks, Ryan, and Barret combination to include signaling the insurance that a contract cannot be formed as taught by Walker since the modification of the method and system with the known technique of signaling a solicitor that a contract cannot be formed would have predictably resulted in notifying the parties involved in the agreement that contract terms may need to be negotiated or reconsidered. See KSR [127 S Ct. at 1739].

Response to Arguments

8. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CANDICE D. CARTER whose telephone number is (571) 270-5105. The examiner can normally be reached on Monday- Thursday 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jamisue Plucinski can be reached on (571)272-6811. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Candice D Carter/
Examiner, Art Unit 3629